



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,265	02/19/2004	Behram Mario Dacosta	50T5776.01	4987

7590 04/27/2005

ROGITZ & ASSOCIATES
Suite 3120
750 B Street
San Diego, CA 92101

EXAMINER

BELIVEAU, SCOTT E

ART UNIT PAPER NUMBER

2614

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/782,265

Applicant(s)

DACOSTA, BEHRAM MARIO

Examiner

Scott Beliveau

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 19 February 2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 19 February 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "22" has been used to designate both the display and the remote control transceiver (Figure 1; Page 4, Lines 13-14). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to because:
 - The term "ALV Storage" should be amended to read "A/V Storage" (Figure 1);
 - The line associated with element "12" appears to be referring to the "Display" as opposed to the entire remote control;

- The specification makes reference to the term “captioning” as being underlined in Figure 1, however the illustration fails to show such.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 4 is objected to because of being grammatically awkward. The examiner suggests rewording the claim to recite “wherein if the selected word is a secondary word, [and the method comprises] displaying a dictionary definition of the selected word” in order to be

consistent with the earlier recitation of the limitation of the primary word. Appropriate correction is required.

5. Claim 26 is objected to because of being grammatically awkward. The examiner suggests rewording the claim to recite “[at least] if the selected word is a primary word, displaying a list of content related to the selected word”. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Dodson et al. (US Pat No. 6,184,877 B1).

In consideration of claim 26, the Dodson reference discloses a system (Figure 1) for implementing a “method for obtaining information from a TV system” (Abstract). The method comprises “permitting a user of a remote control device” [104] “communicating with the TV system” [102] to “enter at least one word into the TV system to establish a selected word” [705] (Figures 3 and 7; Col 3, Lines 28-40) wherein “if the selected word is a primary word” the system “displays a list of content related to the selected word” (Figure 4; Col 3, Lines 41-48).

Claim Rejections - 35 USC § 103

Art Unit: 2614

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 5, 6, 8, 10-12, 14, 15, 17-20, 22, 23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brodsky (US Pat No. 5,809,471) in view of Allport (US Pat No. 6,097,441).

In consideration of claim 1, the Brodsky reference illustrates a system [100] for implementing a “method for obtaining information based on a TV program”. The method comprises “displaying, with the program, closed captioning text” wherein “primary words” (Col 4, Lines 44-47) “in the closed captioning appear differently than remaining secondary words” by virtue of their appearance within a list of selectable keywords. The usage of “primary words” is considered met wherein “primary words” are selected for inclusion within the list of selectable words based upon their relationship with a listing of available topics (Col 4, Lines 44-47). The user is subsequently operable to “select at least one word to establish a selected word” through a user interface [110] wherein “if the selected word is a primary word, [the system] displays a list of content related to the selected word” (Col 5, Lines 11-35; Col 6, Lines 12-42).

The reference, however, is unclear as to the exact composition of the user interface [110] such that it necessarily is associated with a “remote control device communicating with the TV” in order to provide a means to remotely select items appearing on a television screen. In an art related to the problem of user interaction with video distribution components, the

Allport reference discloses the particular usage of a “remote control device” [10] that “communicates with [a] TV” [80] (Figure 2). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to particularly utilize the “remote control device” [10] of Allport for the purpose of advantageously providing a means for displaying the supplemental content in a manner that leaves the primary viewing screen or TV uncluttered by the supplemental content (Col 4, Lines 53-60) and provides the user with the ability to remotely control the selection of items of interest.

In consideration of claim 10, the Brodsky reference discloses a “system” [100] for “obtaining information using a TV closed caption display” [108]. In particular, the system comprises a “TV” [108] for “receiving content from a source, [wherein] the content includes closed caption text” (Col 2, lines 19-23) that is subsequently processed and stored as a dictionary of keywords (Col 4, Lines 49-61). The user is subsequently operable to utilize a user interface [110] (Col 5, Lines 11-20) to “select” “at least one word appearing in the closed caption text” whereupon a “computer” [106] accesses an “accessible data structure” [112] associated with . . . the TV” via a “computer” [106] to “retrieve from the data structure a list of content related to at least one word appearing in the closed caption text and selected by a user” (Col 6, Lines 12-42).

The reference, however, is unclear as to the exact composition of the user interface [110] such that it necessarily is associated with a “remote control device configured for wireless communication with the TV” in order to provide a means to remotely select items appearing on a television screen. The Allport reference discloses the particular usage of a “remote control device” [10] that is “configured for wireless communication with [a] TV” [80]

(Figure 2). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to particularly utilize the “remote control device” [10] of Allport for the purpose of advantageously providing a means for displaying the supplemental content in a manner that leaves the primary viewing screen or TV uncluttered by the supplemental content (Col 4, Lines 53-60) and provides the user with the ability to remotely control the selection of items of interest.

In consideration of claim 18, the Brodsky reference illustrates a “system” [100] for “retrieving content related to a TV program including closed caption text”. The system comprises “means for displaying the TV program with closed caption text” [108] and “means for presenting a list of content associated [a] word” [108] selected by the user (Col 5, Lines 21-35). With respect to the “means for selecting”, it is unclear if the Brodsky reference utilizes an equivalent means in conjunction with the selection of items through a user interface [110]. The Allport reference discloses the particular usage of a remote control device [10] to be used in conjunction with the selection and display of supplemental information or “means for selecting” (Figure 2). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to particularly utilize the “remote control device” [10] of Allport as a “means for selecting at least one word in the closed caption text” for the purpose of advantageously providing a means for selecting and displaying the supplemental content in a manner that leaves the primary viewing screen or TV uncluttered by the supplemental content (Col 4, Lines 53-60) and provides the user with the ability to remotely control the selection of items of interest.

In consideration of claims 2, 11, and 19, Brodsky discloses that the “list is displayed in a picture-in-picture (PIP) window on the TV” (Brodsky: Col 5, Lines 22-35).

With respect to claims 3, 12, and 20, as aforementioned, the Brodsky reference is silent as to the particulars of the user interface [110] involving a “remote control device”. As aforementioned, the Allport reference provides evidence that it is known for a “remote control device” to serve/act as a secondary user interface so as to provide a means for leaving the primary viewing screen or TV uncluttered by a navigational interface (Col 4, line 66 - Col 4, Line 14). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to utilize a “remote control device” such as that disclosed by Allport such that the “list is displayed on a display of the remote control device” for the purpose of advantageously providing a means for displaying the supplemental content in a manner that leaves the primary viewing screen or TV uncluttered by the supplemental content (Col 4, Lines 53-60) and provides the user with the ability to remotely control the selection of items of interest.

Claims 5, 14, and 22 are rejected wherein the Brodsky reference discloses that the system “permits a user to select at least one content on the list and displaying the content” (Brodsky: Col 6, Lines 12-42).

Claim 6 is rejected wherein the Brodsky reference discloses that the “content is obtained from an audio/video data storage” such as a local or remote CD-ROM “associated with the TV” (Brodsky: Col 6, Lines 12-42).

With respect to claims 8, 17, and 25, the Brodsky reference discloses that a “processor” [106] “associated with the TV” [108] is operable to “add the content to a local data storage

Art Unit: 2614

associated with the TV and correlate the content with other content related to the selected word” associated with the pre-fetched content associated with a particular keyword (Brodsky: Col 5, Line 64 - Col 6, Line 11).

In consideration of claims 15, and 23, as aforementioned, the Brodsky reference discloses that the “content is obtained from an audio/video data storage” such as a local or remote CD-ROM “associated with the TV” (Col 6, Lines 12-42). With respect to the particular limitation such that the “computer” [106] is “in the TV”, it is unclear from the illustration if the system of Brodsky is necessarily composed of a single television housing. The Allport et al. reference provides evidence that it is known in the art for a “computer” [155] or processor to be “in the TV” [80] (Allport: Col 9, Lines 19-34; Col 12, Lines 48-51). Accordingly, it would have been obvious to one having ordinary skill in the art, in light of the combined references, so as to utilize a single housing such that the “computer is in the TV” for the purpose of eliminating the cost associated with providing communication channel between the television and the base station. Furthermore, legal precedence provides that “that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.” In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

10. Claims 4, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brodsky (US Pat No. 5,809,471), in view of Allport (US Pat No. 6,097,441), and in further view of Chang (US Pat No. 5,543,851).

In consideration of claim 4, as aforementioned, the combined references enable the user to select “primary words” derived from the closed captioning for which topics relating to

supplemental content exist. The references, however, do not particularly disclose nor preclude a modification such that the user is operable to select additional words or “secondary words” decoded from the closed captioning stream so as to particularly receive a “dictionary definition of the selected word”. The Chang reference provides evidence that it is known for a “user [to] select a word to cause the computer to transmit to the TV a dictionary definition of the word” (Chang: Col 5, Lines 33-43). Accordingly, it would have been obvious to one having ordinary skill in the art so as to modify combined teachings so as to “display a dictionary definition of the selected word” if the “selected word is a secondary word” for the purpose of providing a time efficient means for proving the user with the meaning of a term which appears in the closed caption text (Chang: Col 1, Lines 18-28) even if additional supplemental topical information is not available.

With respect to claims 13 and 21, as aforementioned, the Brodsky reference does not particularly disclose nor preclude that the supplemental information may not include the ability for the “user [to] select a word to cause the computer to transmit to the TV a dictionary definition of the word”. The Chang reference provides evidence that it is known for a “user [to] select a word to cause the computer to transmit to the TV a dictionary definition of the word” (Chang: Col 5, Lines 33-43). Accordingly, it would have been obvious to one having ordinary skill in the art so as to modify combined teachings so as to further provide supplemental information including a dictionary definition of a word for the purpose of providing a time efficient means for proving the user with the meaning of a term which appears in the closed caption text (Chang: Col 1, Lines 18-28).

Art Unit: 2614

11. Claims 7, 9, 16, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brodsky (US Pat No. 5,809,471) in view of Allport (US Pat No. 6,097,441) and in further view of the Encyclopedia Britannica Online article.

In consideration of claims 7, 16, and 24, as aforementioned, the Brodsky reference discloses that the supplemental information from remotely based databases that include encyclopedias may be “downloaded” from broadcasters or dial-up service providers “in response to the user selecting the content” (Brodsky: Col 6, Lines 12-42). However, the reference does not explicitly disclose that the supplemental information may be “downloaded from at least one of: the Internet, and a transmitter head end”. The Allport reference provides evidence that it is known to download information from the Internet [95] through a dial-up connection [135], but does not explicitly disclose the particular usage of the Internet to access remote encyclopedias. The “Encyclopedia Britannica Online” article provides evidence that the Internet based encyclopedias are known in the art. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to “download from at least one of: the Internet . . . ” encyclopedia information such as provided by “Encyclopedia Britannica Online” for the purpose of utilizing the most complete compendium of general knowledge on the Internet as a source of supplemental data.

Claim 9 is rejected wherein the article provides evidence that it is known to “bill the user for downloading content” in connection with a subscription fee to access the online encyclopedia.

Conclusion

Art Unit: 2614

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Tomsen et al. (US Pub No. 2002/0147984 A1) reference discloses a system and method for performing a search in order to retrieve supplemental content related to a television broadcast.
- The Shinohara (US Pub No. 2003/0005461 A1) reference discloses a system and method for linking closed captioning to web sites.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/782,265

Page 13

Art Unit: 2614

A handwritten signature in black ink, appearing to read 'SEB', is located above the typed name.

SEB

April 11, 2005